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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	09/731,264
		Filing Date	December 5, 2000
		First Named Inventor	Bonner, Benjamin A.
		Art Unit	1765
		Examiner Name	Duy Vu Nguyen
Total Number of Pages in This Submission	4	Attorney Docket Number	A5082/T39700

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Signature	<i>William L. Shaffer</i>
Date	4/10/03

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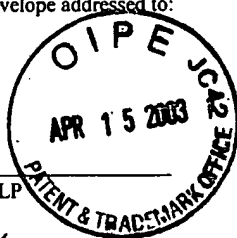
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AMENDMENT UNDER 37 CFR 1.116
EXPEDITED PROCEDURE –
EXAMINING GROUP 1765

Attorney Docket No.: A5082/T39700 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BENJAMIN A. BONNER et al.

Application No.: 09/731,264

Filed: December 5, 2000

For: MULTI-STEP POLISH PROCESS
TO CONTROL UNIFORMITY
WHEN USING A SELECTIVE
SLURRY ON PATTERNED
WAFERS

Examiner: Duy Vu Nguyen Deo

Art Unit: 1765

RESPONSE

#10
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Sir:

In response to the Final Office Action mailed February 11, 2003, and for the purpose of putting the application in condition for allowance, please consider the following comments.

REMARKS

Claims 1-13 are pending.

Claims 1 and 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. (JP 11-138418).

Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida.

Claims 7, 9 and 11-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida and further in view of Woo (USP 5,816,891).

Claims 2, 4, 8 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida or Yoshida/Woo and further in view of admitted prior art.

Claims 1 and 7 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification.

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

Telephone Interview

Applicants thank the Examiner for the time he spent discussing this case by telephone on April 4, 2003. During the interview, Applicants explained why the Section 102 rejection of claims 1 and 3 under Yoshida was improper. Specifically, the Office Action states that there is no roughening of the pad in Yoshida between the first and second polishing steps (col. 13, lines 1-36) because the "surface is restored to its original condition." The Office Action also notes, however, that between the first and second polishing steps the pad is rinsed and dressed. Col. 7, lines 43-48 of Yoshida explain that dressing the pad results in "roughening the polishing surface of the polishing pad." Thus, Applicants stated their belief that Yoshida does indeed roughen the pad between the first and second polishing steps and thus does not anticipate claims 1 and 3 which require that the pad is "not roughened ... between polishing the first and second portions of the material."

The Examiner seemingly agreed with this argument. Accordingly, Applicants respectfully request withdrawal of the Section 102 rejection. Applicants also request withdrawal of the Section 103 rejections of claims 2 and 4-13 which are all based on Yoshida being the primary reference and the Examiner's prior belief that Yoshida did not roughen the pad between its first and second polishing steps.

Applicants and the Examiner also discussed the Section 112 rejection that rejects the pending claims on the grounds that the Specification does not disclose the limitation "wherein the polishing pad is not roughened by a pad conditioner between polishing the first and second portions of the material." Agreement on this issue between the Examiner and Applicants was not reached.

Applicants pointed out that page 5, line 30 to page 6, line 19 of the Specification specifically describe an embodiment of the invention where, in order, (i) a substrate is polished in a first polishing step; (ii) the polishing pad is rinsed with a rinsing fluid; and (iii) the substrate is polished in a second polishing step. In this embodiment it is also specifically stated that "[c]onditioning of pad 17 is done sometime after step 130 [the second polishing step] when wafer W has been completely polished." Page 6, lines 16-17.


Applicants would like to remind the Examiner that it has been long held that "*ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question." *Fujikawa v. Wattanasin*, 39 U.S.P.Q.2d 1895, 1904 (Fed. Cir. 1996) (citation omitted); *In re Alton*, 37 U.S.P.Q.2d 1578, 1584 (Fed. Cir. 1996) ("If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.").

Applicants respectfully assert that a person of skill in the art would readily appreciate that in the embodiment of the invention disclosed at pages 5-6 of the Specification and discussed above, conditioning of the pad (i.e., roughening the pad, for example, with an abrasive disk having embedded diamond crystals - page 5, lines 4-6) is not performed between the first and second polishing steps. Thus, Applicants respectfully assert that the limitation "wherein the polishing pad is not roughened by a pad conditioner between polishing the first and second portions of the material" previously added to independent claims 1 and 7 is not new matter and that the pending claims meet all requirements under 35 U.S.C. §112. Accordingly, Applicants request withdrawal of the Section 112 rejection and allowance of the pending claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 650-326-2400.

✓
Respectfully submitted,


William L. Shaffer
Reg. No. 37,234